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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,192	08/18/2000	Steven G. LeMay	IGT1P031	6816

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/30/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,192

Applicant(s)

LEMAY ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 and 47-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 22, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-44 and 47-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, claims 1, 24 and 44 include the limitation, "...player tracking services are provided without separate player tracking hardware unit including 1) player tracking devices...". However, figure 3 of applicant's disclosure clearly illustrates devices including a display (305), keypad (310) and card reader (315). These constitute separate player tracking hardware units. Hence, the claims are not enabled. Claims 2-23, 25-43 and 47-53 are rejected because they inherit the deficiency from claims 1, 24 and 44.

Claim Rejections - 35 USC § 103

Claims 1, 2, 4, 6, 7, 11, 12, 15, 16, 18, 19, 23, 24, 32, 34, 37-39, 41-44, 47-50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, U.S. Patent 6,113,492 (Sep. 5, 2000) in view of Johnson et al., U.S. Patent 5,149,945 (Sep. 22, 1992).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 5, 8, 35, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Johnson, as applied to claims 1, 24 and 44 above, in further view of Acres, U.S. Patent 6,317,852 (Apr. 16, 2002) (hereinafter "Acres '832").

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 9, 10 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Johnson, as applied to claims 1, 24 and 44 above, in further view of Lichtman, U.S. 5,819,107 (Oct. 6, 1998).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Johnson, as applied to claims 1, 24 and 34 above, in further view of Boushy, U.S. Patent 6,183,362 (Feb. 6, 2001).

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This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 17, 21, 22, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Walker* in view of *Johnson*, as applied to claims 1, 24 and 34 above, in further view of Acres et al., U.S. Patent 5,702,304 (Dec. 30, 1997) (hereinafter "*Acres '304*").

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Walker* in view of *Johnson*, as applied to claims 1, 24 and 44 above, in further view Pease, U.S. Patent 5,766,076 (Jun. 16, 1998) and Kelly, U.S. Patent 6,293,865 (Sep. 25, 2001)

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments with respect to claims 1-44 and 47-53 have been considered but are moot in view of the new grounds of rejection.

The applicant argues that the prior art does not teach or suggest the claimed features of a gaming device providing player tracking services wherein the services are provided without a separate player tracking hardware unit including (1) player tracking devices and (2) a processor, separate from the master

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game controller and connected to player tracking device, executing player tracking software for operating player tracking devices. The examiner respectfully disagrees.

The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case *Walker* teaches a gaming device including a master gaming controller designed and configured to (i) control games played on a gaming machine and (ii) provide player tracking events by performing player tracking functions including (a) evaluating player tracking events, (b) directly controlling operating features of a plurality of physical devices in response to player tracking events, (c) execute player tracking software that allows the plurality of physical devices to perform the functions of a player tracking unit. *See fig. 1, 6, 7; col. 14:65-15:24*. Furthermore, it includes an input device for inputting player-tracking information into a gaming system; a communication interface for transmitting player-tracking information to a site outside the gaming machine; and a memory storing player tracking software that allows the master gaming controller to operated on the tracking event and allows the master gaming controller to provide gaming services. *See id.*

Johnson discloses a smart card reader device coupled directly to a host processor such as, a personal computer, point of sale device or the like. The system provides the advantage of reduced cost and complexity by eliminating the need to incorporate separate microprocessor in the card reader. *See col. 2:38-44*. Hence, *Johnson* suggests a point of sale device having a card reader system without separate hardware or processor allowing the card reader to execute software for reading data from smart card. Instead, the card reader simply provides means for transferring smart card data from a card to the main processor of the point of sale device where software is executed to process the data.

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The smart card reader system described by *Johnson* is equivalent to the player tracking system claimed by the applicant. Thus, when the prior art is taken as a whole, by an artisan, it collectively suggests a gaming device providing player tracking services wherein the services are provided without a separate player tracking hardware unit including (1) player tracking devices and (2) a processor, separate from the master game controller and connected to player tracking device, executing player tracking software for operating player tracking devices.

The applicant argues further that the claimed invention distinguishes over the gaming device described by the combination of *Walker* with *Johnson* because the combination does not describe the claimed feature of a player tracking unit without a separate player tracking hardware unit. More specifically, the applicant asserts that the combination of *Walker* and *Johnson* still requires a separate hardware unit. The examiner respectfully disagrees. The claims state "... without a separate player tracking hardware unit including (1) player tracking devices and (2) a processor...". However, the applicant's drawings clearly illustrate player tracking devices including a card reader, keypad, and display. *See fig. 3(300)*. Based on the applicant's arguments, the examiner interprets the claim language to mean that execution of software for player tracking services does not occur in the player tracking devices, but instead at the main game controller. As discussed above, the examiner maintains that *Johnson* suggests modifying the gaming device described by *Walker* such that player tracking services do not occur in the player tracking device, but instead are executed by hardware and software contained in the main controller.

The applicant argues further that the claimed invention distinguishes over the gaming device described by the combination of *Walker* with *Johnson* because purpose of the claimed invention is to overcome disadvantages caused by regulatory requirements. The examiner respectfully disagrees. The

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fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, *Johnson*, suggests modifying the gaming device disclosed by *Walker* to reduce the cost and complexity by eliminating the need to incorporate separate microprocessor for the card reader. See col. 2:38-44.

The applicant argues further that there is no motivation to combine *Walker* with *Johnson* because *Johnson* is nonanalogous art. The examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *Johnson* describes a card reader for a point of sale device. Gaming devices are a type of point of sales device. Hence *Johnson* is in the field of the applicant's endeavor. Additionally, *Johnson* is reasonably pertinent to the particular problem with which the applicant was concerned. Namely, providing processor control over a card-reader device with the need for an separate controller in the peripheral.

Consequently, for all the reasons given above, the rejection of claims 1-44 and 47-53 is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

s.a.

September 29, 2003



MARK SAGER
PRIMARY EXAMINER